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OFFICE OF PETITIONS

In re Patent No. 7,056,510 : DECISION ON REQUEST FOR  
Choi et al. : RECONSIDERATION OF  
Issue Date: June 6, 2006 : PATENT TERM ADJUSTMENT  
Application No. 08/961,083 : and  
Filed: October 30, 1997 : NOTICE OF INTENT TO ISSUE  
Attorney Docket No. PB340P2 : CERTIFICATE OF CORRECTION  
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This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) AND PETITION UNDER 37 C.F.R. § 1.181(a)(3)," filed August 4, 2006. Patentees request that the patent term adjustment indicated on the face of the patent be corrected from zero (0) days to at least nine hundred forty-two (942) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of NINE HUNDRED FORTY-TWO (942) days.

On June 6, 2006, the above-identified application matured into U.S. Patent No. 7,056,510, with a revised patent term adjustment of 0 days. On August 4, 2006, patentees timely submitted this request for reconsideration of patent term adjustment (with required fee) within 2 months of the issuance of the patent. Patentees point out that the patent issued without regard to the decision on petition mailed January 3, 2005 correcting the initial determination of PTA from 0 days to 388. The decision on petition was made due to an affirmation on the part of the Office that the application was eligible to PTA based on examination delay based on a CPA having been filed in the

application on December 11, 2000. Patentees contend that giving the decision effect a period of adjustment of 554 days should be entered for the period from four months after the issue fee was paid on July 29, 2004 until the patent issued on June 6, 2006. See § 1.703(a)(6). Alternatively, patentees contend that the PTA should be increased by 908 days for the period noted in 37 C.F.R. § 1.703(b) between the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 1.111(a) (December 12, 2003) and the date the patent issued (June 6, 2006). Patentees acknowledge that to the extent that periods of delay attributable to the grounds specified in 37 C.F.R. § 1.702 overlap, the period of adjustment will not exceed the actual number of days the issuance of the patent was delayed (35 U.S.C. 154(b)(2)(A)).

Pertinent to this case, 37 C.F.R. § 1.703(a) provides that:

The period of adjustment under § 1.702(a) is the sum of the following periods:

- (1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;
- (6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

As stated by patentees and as reflected in the decision mailed January 3, 2005, pursuant to § 1.702(a)(1), the application should have been accorded a period of adjustment of 388 days for Office delay in mailing a first notification under 35 U.S.C. 132, a restriction requirement mailed March 6, 2003.

Further, patentees are correct that there was an Office delay in issuing the patent within the meaning of § 1.703(a)(6). Patentees are also correct that the period of adjustment for this delay is 554 days.

Finally, the patent did issue three years and 908 days after the application filing date. Also as indicated by patentees, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, it is properly concluded that the 908 days totally overlaps with the 942 days already accorded. Thus, no additional days will be accorded.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

In view thereof, the patent should have issued with a revised patent term adjustment of nine hundred forty-two (942) days (388 + 554).

The Certificates of Correction Branch has been advised of this decision. The Certificates of Correction Branch is thereby forwarded this application for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **nine hundred forty-two (942)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT : 7,056,510 B1  
DATED : June 6, 2006  
INVENTOR(S) : Choi et al.

*DRAFT*

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (0) days

Delete the phrase "by 0" and insert – by 84 days--